REMARKS

Applicant respectfully requests reconsideration and allowance of claims 1-6 that are pending in the above-identified patent application in view of the following remarks.

In numbered part 2 of the Office Action, page 2, the Examiner noted that Applicant does not present any specific discussion regarding claims 7-10 and that the Examiner "treats the instant claims as being canceled." Applicant respectfully submits that in Paper No. 7, the September 28, 2001 Response, in response to a restriction requirement, Applicant elected Group I, referring to claims 1-6 and withdrew claims 7-10 accordingly. In Paper No. 8, the November 7, 2001 Office Action, Examiner Tundra acknowledged that claims 7-10 were withdrawn. Applicant has since filed a divisional application, which includes claims 7-10. Accordingly, Applicant does not believe that a specific discussion regarding claims 7-10 is appropriate in the present application.

In numbered parts 3 and 4 of the Office Action, page 3, the Examiner rejected claims 1-6 under 35 U.S.C. §102(e) as being anticipated by *Marshall, et al* (US Pat. No. 6,542,169 B1). Specifically, with respect to independent claims 1 and 4, the Examiner asserts that *Marshall* teaches a receiving means that receives multiplexed data and EPG data and refers Applicant to col. 2, lines 55-67. The Examiner further asserts that *Marshall* separates the EPG data from the broadcast data. Finally, the Examiner asserts "[a]s for the amended claimed feature of the EPG having predetermined time slots independent of the broadcast times, and have varying length[s]", the *Marshall* discloses that at col. 3, lines 55-65 and Fig. 4. Applicant respectfully traverses this rejection of independent claims 1 and 4 because *Marshall* fails to disclose each and every element of independent claims 1 and 4.

In particular, *Marshall* states:

> Turning first to FIG. 1, the components of the interactive scroll program guide are illustrated. A computer 11 having a command information receiver, preferably an infrared or radio frequency receiver 13, provides a control signal 15 to a tuner 17 and a picture image signal 19 to a digital video board 21. The tuner 17 converts or demodulates radio frequencies or optical transmission to a signal usable by the viewer to output a signal 23 selected from a plurality of signals 25 input to the tuner 17 from the cable source (not shown), typically frequency division multiplexed video, audio and data signals transmitted via a coaxial cable, over-the-air radio frequencies or fiber optics." (*Marshall*, col. 2, lns. 55-67)

Indeed, *Marshall* fails to teach or disclose a "receiving means for receiving multiplexed signals". Rather, *Marshall* merely describes a tuner 17 that converts or demodulates radio frequencies or optical transmission to a signal usable by a viewer to output a signal 23 selected from a plurality of signals 25 input to the tuner 17 from a cable source.

Applicant presumes that the "plurality of signals 25" "typically frequency division multiplexed video, audio and data signals transmitted via a coaxial cable, over-the-air radio frequencies or fiber optics." Therefore, *Marshall* does not disclose or teach receiving multiplexed signals (or for that matter multiplexed data and EPG data), but rather a plurality of signals that may or may not be frequency division multiplexed video, audio and data signals.

In addition, the Examiner asserts that *Marshall* teaches a system that "separates the EPG data from the broadcast data." Again, Applicant respectfully submits that *Marshall* neither teaches nor discloses the feature of "separation means for separating the program guide information in the multiplexed signals from the broadcast signals." In fact, *Marshall* is silent to any type of separation of the plurality of signals 25

into the tuner 17. Although *Marshall* does describe output signal 23, it does not disclose or teach whether that output signal is a portion of a de-multiplexed plurality of signals. Furthermore, although depicted in FIG. 1, the *Marshall* specification does not describe what reference No."16" represents. Thus, *Marshall* fails to disclose a system that separates the program guide information from the broadcast signals, *i.e.*, the EPG data from the broadcast data.

Claims 1 and 4 also include a "plurality of time slots each having a predetermined length of time independent of the program broadcast times, and for allocating each program to at least one of the plurality of time slots based on the broadcast time of the program, wherein the programs have varying lengths of time." Applicant respectfully submits that *Marshall* fails to disclose or teach these features. The Examiner asserts that *Marshall* discloses these features at col. 3, lns. 55-65 and FIG. 4. A closer review of this section of the specification reveals the contrary:

> Looking at FIG. 4, the viewer display screen 33 displays, on approximately its top half, the display defined by the viewer usable signal 23 passed by the tuner 17 (display not shown). It also displays, on approximately the bottom half, a first horizontal data slot divided into vertical columns indicating the proper date 201 and second the program times, as shown, in two half hour increments 203 and 205. Second, third and fourth horizontal data slots are divided into a vertical column showing sequential channel identifications 207, 209 and 211 and into other vertical columns showing program identification data for corresponding channels and times 213, 215 and 217. (*Marshall* col. 3, lns. 55-66).

Not only does *Marshall* not teach or disclose the aforementioned features of independent claims 1 and 4, but *Marshall* actually teaches away from those limitations. Specifically, referring to

FIG. 4 of *Marshall*, each and every time slot depicted is of the exact same length equivalent to two half hour increments. *See* Ref. No. 203. For example, in FIG. 4, all the time slots disclosed are of the same length, i.e., a total of an hour.

Furthermore, and significantly, the Examiner does not address an additional feature of independent claims 1 and 4, which is neither taught nor disclosed in *Marshall*. That is, the presently claimed invention includes the feature of "allocating each program to at least one of the plurality of time slots based on the broadcast time of the program." In contrast, *Marshall* discloses programs being slotted to the same set of time slots no matter what the program broadcast time. For example, in FIG. 4, the program "There Goes the Neighborhood (Comedy)" is placed in a time slot of equal length between 4:00 and 5:00 PM. Directly below is another program "Murder by Death (Comedy)" which is placed in a time slot of identical length between 4:00 and 5:00 PM. Finally, and most significantly, the program "Tulsa Public Schools TJC Telecourses (CC)" is placed directly below the previous program in the exact same sized time slot having the exact same length slot as the previous two programs, even though this broadcast would appear to be longer than the time slot between 4:00 and 5:00 PM.

Thus, whereas the presently claimed invention includes a production means for producing a retrieval table that consists of a plurality of time slots having predetermined lengths of time independent of the program broadcast times, but in which there is an allocation of each program to one of the plurality of time slots based on the broadcast time of the program and wherein the programs have varying lengths of time, *Marshall* places all programming, regardless of its length of time, into equal lengthed time slots.

Based upon the foregoing, Applicant submits that independent claims 1 and 4 are patentable over the *Marshall*

reference in that *Marshall* fails to disclose or teach each and every element of the aforementioned claims.

In addition, Applicant submits *Marshall* actually teaches away from at least certain of those features of independent claims 1 and 4. Accordingly, Applicant respectfully requests the Examiner's §102(e) rejection be withdrawn. Further, dependent claims 3 and 6 depend from independent claims 1 and 4 respectively, and contain all of the limitations thereof, as well as other independently patentable features. Accordingly, Applicant submits that these dependent claims are likewise patentable.

In numbered parts 5 and 6 of the Office Action, page 4, the Examiner rejected dependent claims 2 and 5 under 35 U.S.C. §103(a) as being unpatentable over *Marshall*. Specifically, with respect to claim 5, the Examiner asserts that *Marshall* does not discuss displaying the EPG according to genre and attempts to overcome this deficiency by taking Official Notice that "at the time the invention was made storing and retrieving EPG programming according to genre or categories was well known in the art." The Examiner concludes therefore it would have been "obvious. . .to modify *Marshall* to display an EPG according to genre for the known improvement of a more targeted and useful interface, which helps the subscribers choose programming that they are more likely interested in viewing." The Examiner does not specify the reason for the rejection of claim 2. Thus, Applicant will therefore assume that claim 2 stands allowed. With respect to claim 5, Applicant respectfully traverses this rejection.

Initially, Applicant submits that in accordance with the aforementioned discussion, the *Marshall* reference neither discloses nor suggests or teaches each and every element of independent claims 1 and 4 from which dependent claims 2 and 5 depend, respectively. Accordingly, Applicant submits claims 2

and 5 are patentable over the *Marshall* reference and that it is inappropriate to use the *Marshall* reference either by itself or in combination with Official Notice to render the dependent claims 2 and 5 unpatentable.

Further, the taking of Official Notice fails to remedy the deficiencies of the *Marshall* reference in connection with the particular features of independent claims 1 and 4, discussed hereinabove. Accordingly, Applicant submits that the cited combination of *Marshall* and Official Notice fails to render dependent claims 2 and 5 unpatentable. As such, Applicant respectfully requests the Examiner withdraw his §103(a) rejection thereof.

In addition to the above, Applicant respectfully submits that the Examiner's Official Notice is improper. It is inappropriate to take Official Notice without documentary evidence to support the Examiner's conclusion. "Official Notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." M.P.E.P. §2144.03(A). Here, the Examiner takes Official Notice that it would have been obvious to modify *Marshall* to display an EPG according to genre. Applicant submits that it is not appropriate to take such Official Action without citing a prior art reference or other documentary evidence. That is, "[t]he Examiner must provide specific factual findings predicated on sound, technical and scientific reasoning to support his or her conclusion of common knowledge. . . The Applicant should be presented with the explicit basis on which the Examiner regards the matter as subject to Official Notice and be allowed to challenge the assertion in the next reply after the Official Action in which the common knowledge statement was made." M.P.E.P. §2144.03(B). (Citations omitted.)

Applicant respectfully submits that merely stating it would have been obvious to modify *Marshall* to display an EPG according to genre for the known improvement of a more targeted and useful interface is not sufficient to support the Examiner's Official Notice of common knowledge. Therefore, Applicant respectfully requests the Examiner provide substantial evidence on the record to support his assertion of the above-identified Official Notice taken.

In addition to the above, assuming, *arguendo*, the Examiner's rejection under §103(a) "by way of the *Marshall* reference in view of Official Notice" is proper, Applicant respectfully submits it would be improper to combine the suggested disclosures from *Marshall* with the Official Notice of displaying an EPG according to genre because such modification would render the *Marshall* reference unsatisfactory for its intended purpose and change the principal of operation of the *Marshall* system. Indeed, if *Marshall* were to rearrange its program data slots on a scroll grid according to genre, then the intent of *Marshall* would be circumvented, rendering the *Marshall* system unsatisfactory for its intended purpose. It is well settled that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose (as is the case here), then there is no suggestion or motivation to make the proposed modification. M.P.E.P. §2143.01.

It is also well settled that if the proposed modification or combination of the prior art would change the principal of the operation of the prior art invention being modified (as is the case here), then the teaching of the references are not sufficient to render the claims *prima facie* obvious. M.P.E.P. §2143.01. Here, the principal of operation of *Marshall* is to advance, backup and freeze a scroll output picture image signal. *Marshall* is not intended to modify the content of the scroll

data, or the position in which the content is presented, but rather to manipulate the speed at which the data received is transmitted to the viewer.

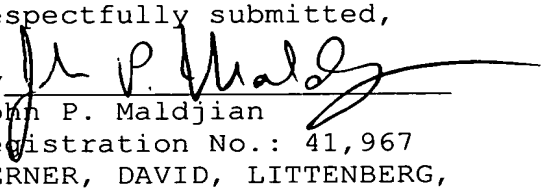
Finally, even if the *Marshall* reference was modified as the Examiner suggests, the combination would not disclose or suggest each and every feature of the dependent claims of the instant application. Accordingly, Applicant respectfully submits that the Examiner's reliance on the combined teachings of the *Marshall* reference and his Official Notices is untenable and should be withdrawn.

In view of the foregoing, Applicant submits that the instant claims are in condition for allowance. Early and favorable action is earnestly solicited. If, however, for any reason the Examiner does not believe such action can be taken at this time, he is respectfully requested to telephone Applicant's attorney at 908-654-5000 in order to overcome the additional objections he may have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: April 14, 2004

Respectfully submitted,

By 

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